



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,763	12/22/2000	Kenneth Jacobs	GIN-6046CP	7028

959 7590 09/27/2002

LAHIVE & COCKFIELD  
28 STATE STREET  
BOSTON, MA 02109

EXAMINER
----------

KAM, CHIH MIN

ART UNIT	PAPER NUMBER
----------	--------------

1653

DATE MAILED: 09/27/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application N .</b>	<b>Applicant(s)</b>	
	09/745,763	JACOBS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chih-Min Kam	1653	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-264 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-264 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Claims 138 and 148 are referred to SEQ ID NO:9, and claims 259 and 261 are referred to SEQ ID NO:24, which are obvious typographic errors according to the polynucleotide and polypeptide pairing, thus, claims 138 and 148 are read as being related to SEQ ID NO:107, and claims 259 and 261 are related to SEQ ID NO:204.

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U. S. C. 121:

Inventions of Set I. Inventions 1-67 (claims for each invention and the related "SEQ ID NO:" are listed below), are drawn to an isolated polynucleotide comprising or related to a specific nucleotide sequence identified by "SEQ ID NO:", a vector, a host cell, a gene corresponding to the cDNA of the specific nucleotide sequence, and a process of producing a protein recombinantly, classified in class 536, subclass 23.1, and 435, subclasses 69.1, 320.1 and 325.

Invention	Claims	SEQ ID NO:
1	1-5, 12	1
2	13, 15	3
3	16, 18	8
4	19, 21	10
5	22, 24	12
6	25, 27	14
7	28, 30	16
8	31, 33	18
9	34, 36	20
10	37-41, 49	33
11	50, 52	35
12	53, 55	37
13	56, 58	39
14	59, 61	41
15	62, 64	43
16	65, 67	45

Art Unit: 1653

17	68, 70	47
18	71, 73	49
19	74, 76	51
20	77-81, 89	65
21	90, 92	67
22	93, 95	69
23	96, 98	71
24	99, 101	73
25	102, 104	76
26	105, 107	78
27	108, 110	81
28	111, 113	84
29	114, 116	86
30	117-120, 128	99
31	129, 131	101
32	132, 134	103
33	135, 137	105
34	138, 140	107
35	141, 143	109
36	144, 146	112
37	147, 149	114
38	150, 152	116
39	153, 155	118
40	156-160, 167	133
41	168, 170	135
42	171, 173	137
43	174, 176	139
44	177, 179	141
45	180, 182	143
46	183, 185	145
47	186, 188	147
48	189, 191	149
49	192, 194	151
50	195-199, 205	163
51	206, 208	165
52	209, 211	167
53	212, 214	169
54	215, 217	171
55	218, 220	173
56	221, 223	175
57	224, 226	177
58	227-231, 237	188
59	238, 240	190

Art Unit: 1653

60	241, 243	192
61	244, 246	194
62	247, 249	196
63	250, 252	198
64	253, 255	200
65	256, 258	202
66	259, 261	204
67	262, 264	206

Inventions of Set II. Inventions 68-134 (claims for each invention and the related "SEQ ID NO:" are listed below), drawn to a protein comprising or related to an amino acid sequence identified by "SEQ ID NO:", and a composition comprising the protein, classified in class 530, subclasses 324 and 350.

Invention	claims	SEQ ID NO:
68	8-10	2
69	14	4
70	17	9
71	20	11
72	23	13
73	26	15
74	29	17
75	32	19
76	35	21
77	42-47	34
78	51	36
79	54	38
80	57	40
81	60	42
82	63	44
83	66	46
84	69	48
85	72	50
86	75	52
87	82-87	66
88	91	68
89	94	70
90	97	72
91	100	74
92	103	77

Art Unit: 1653

93	106	79
94	109	82
95	112	85
96	115	87
97	122-126	100
98	130	102
99	133	104
100	136	106
101	139	108
102	142	110
103	145	113
104	148	115
105	151	117
106	154	119
107	161-166	134
108	169	136
109	172	138
110	175	140
111	178	142
112	181	144
113	184	146
114	187	148
115	190	150
116	193	152
117	200-204	164
118	207	166
119	210	168
120	213	170
121	216	172
122	219	174
123	222	176
124	225	178
125	232-236	189
126	239	191
127	242	193
128	245	195
129	248	197
130	251	199
131	254	201
132	257	203
133	260	205
134	263	207

Art Unit: 1653

Inventions of Set III. Inventions 135-138 (claims for each invention and the related "SEQ ID NO:" are listed below), drawn a method for preventing, treating or ameliorating a medical condition, comprising administering a composition comprising the protein identified by a "SEQ ID NO:", classified in class 530, subclasses 324 and 350.

Invention	claims	SEQ ID NO:
135	11	2
136	48	34
137	88	66
138	127	100

2. The inventions are distinct, each from the other because of the following reasons:

The polynucleotide of Inventions of Set I is related to the protein of Inventions of Set II because the polynucleotide encodes the claimed protein. The inventions are distinct because they are physically and functionally distinct chemical entities, and the protein can be made by another and materially different process such as chemical peptide synthesis. Further, the polynucleotide can be used for a process other than the production of the protein such as nucleotide hybridization assay.

The methods of Inventions of Set I and the proteins of Inventions of Set II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the protein as claimed can be made by chemical peptide synthesis.

The product of Inventions of Set II and the method of Inventions of Set III are related as product and process of use. The inventions can be shown to be distinct if either or both of the

Art Unit: 1653

following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein can be used for producing the antibodies.

The polynucleotides of Inventions of Set I is distinct from the methods of Inventions of Sets III because the products of Inventions of Set I can be neither made by nor used in the methods of Inventions of Sets III.

The methods of Inventions of Sets I and III are distinct from each other because they have different method steps, use different materials and have different effects.

In the Inventions of Set I, each polynucleotide is considered patentably distinct invention because each polynucleotide contains different nucleotide sequence, and has different function and utility.

In the Inventions of Set II and Set III, each amino acid sequence is considered patentably distinct invention because each protein has different chemical property, and produces different effect in the method of treatment.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, and because Inventions of Sets I-III require different searches but are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.



Art Unit: 1653

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CTK*  
Patent Examiner

\*\*\*

September 25, 2002

*Christopher S. F. Low*  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600